

**REMARKS**

Claims 1 – 38 are pending in this application; Claims 1, 2, 4, 5, 8 – 18, and 34 – 38 have been amended in several particulars to overcome the §112 rejection.

Upon a careful review of the Advisory action (Paper No. 15) mailed on 23 December 1994, Applicant notes that:

- Claims 1, 3, 4, 6 – 8, 17, as previously amended in Applicant's Amendment filed on 19 December 1994, and claims 23 – 33 have been allowed over the prior art of record without the necessity for amendments. Accordingly, the same proposed amendments to claims 1, 3, 4, 6 – 8, 17 is hereby submitted so as to place these claims in condition for allowance.
- The objection to FIG. 3 for not being labeled as "Prior Art" has been withdrawn.
- The objection to the specification for containing numerous grammatical errors has been withdrawn in view of the filing of the substitute specification on 19 December 1994.
- The substitute specification filed on 19 December 1994 has been entered.
- The objection to the Abstract of the Disclosure for using the word "means" has been withdrawn.
- The objection to the Disclosure for failing to discuss FIGs. 1 – 3 in the "background of the invention" section as specified under MPEP §608.01(d) has been withdrawn.
- Applicant's Amendment under 37 CFR §1.116(b) filed on 19 December 1994 has been indicated by the Examiner as will be entered upon the filing of an appeal.

Consequently, the only remaining issues in this application are the objection of claims 34 – 38 and the rejection of claims 2, 5, 9 – 16, 18 – 22 and 37 under 35 U.S.C. §112, second paragraph as is noted in the Advisory action.

With regard to the objection of claims 34 – 38, Applicant notes that the Examiner has not provided any statutory basis to support this objection. MPEP §707.07(d) requires the Examiner "to designate the statutory basis for any ground of rejection by express reference to a section of 35 U.S.C in the opening sentence of each ground of rejection. If the claim is rejected as ... indefinite the examiner should point out wherein the indefiniteness resides; if rejected as incomplete, the element or elements lacking should be specified, or the applicant be otherwise as to what the claim requires to render it complete." Since the Examiner has not pointed out why claims 34 – 38 were indefinite, Applicant took the liberty to amend these claims to the extent that is necessary to avoid potential §112 issues and to provide proper antecedent basis for the term "memory means" as recited in claims 34 and 37, the "second data" as recited in claims 35, 36 and 38. Consequently, claims 34 – 38, as amended herewith, are believed to be in condition for allowance. Should the Examiner, however, believe that claims 34 – 38 continues to suffer §112 problems, he is respectfully requested to telephone Applicant's undersigned attorney so that the prosecution of the application could be concluded without delay.

Similarly, claims 2, 5, 11 – 16, and 19 – 22 were **never** specifically rejected by the Examiner; consequently, these claims are presumed to have raised §112 problems after the filing

of Applicant's Amendment under 37 CFR §1.116(b) on 19 December 1994. Accordingly, these claims have been carefully reviewed and amended to avoid all possible §112 issues in order to place themselves in condition to be passed to issue.

Specifically, claim 2 has been amended to provide proper antecedent basis for the term "successive field periods." Claim 5 has been amended to clarify the printing operation of different colors of the second data. Consequently, claims 2 and 5 are believed to be condition for allowance.

With regard to claim 9, although the Examiner has noted in the Advisory action (Paper No. 15) that the previous amendments to claim 9 raised new §112 issues, Applicant has, however, reviewed claim 9, and believes that claim 9, as amended herewith, is in fact free of any form of ambiguities. Should the Examiner believe that claim 9 continues to suffer §112 problems, he is respectfully requested to telephone Applicant's undersigned attorney so that the prosecution of the application could be promptly concluded without further delay.

Similarly, with regard to claim 10, there is no basis for the Examiner to continue rejecting claim 10 under 35 U.S.C. §112, **second** paragraph. In the "final" Office action (Paper No. 12), the Examiner asserted that "the recitation of more than one function for the data conversion means makes the structure indefinite since it is not clear what part of the data conversion means is performing each of the 2 different functions." This assertion is however in error for two

reasons. First, claim 10 is written in a means-plus-function format as is permissible under 35 USC §112, **sixth** paragraph; consequently, "the recitation of more than one function for the data conversion means" does not make the structure indefinite because the claim does not specify the structure. Second, 35 USC §112, **sixth** paragraph expressly mandates:

"An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

The statute simply does not prohibit the drafter of claims to draft the "data conversion means" to perform only one specified function. Moreover, as is commonly known in patent practice, a single means written in a means-plus-function format can comprise more than one function. To further demonstrate this common practice, the Examiner's attention is invited to examine allowed claims in the cited U.S. Patent No. 5,291,313 issued to Kim, U.S. Patent No. 5,216,514 issued to Hong et al., U.S. Patent No. 5,115,320 issued to Ebihara et al. Specifically, the Examiner's attention is directed to the issued claim 1 of the Kim patent which requires "microcomputer means" performing more than two functions (*i.e.*, for calculating an average value ... for comparing said average value with a predetermined value ... and for switchably connecting ...) Similarly, claim 1 of the Hong patent also calls for "video processor means" for performing a first function, *i.e.*, "processing an input video signal" and for performing a second function, *i.e.*, "selectively generating an output"). Consequently, there is no statutory basis for the Examiner to maintain this rejection.

Further, there is also no basis for the Examiner to reject claim 10 under 35 U.S.C. §112, second paragraph for being incomplete on the ground that "it is not clear ... what element is doing the printing." Claim 10 had already been amended in Applicant's previous Amendment under 37 CFR §1.116(b) to include an additional printer means for performing the printing. Consequently, this rejection should be withdrawn. Again, should the Examiner believe that claim 10 suffers additional §112 problems, he is respectfully requested to telephone Applicant's undersigned attorney in order to promptly conclude prosecution of the instant application.

With regard to claims 11 – 16 and 19 – 22, these claims have been carefully reviewed and confirmed that they are in fact clear and definite so as to avoid any potential §112 problems. Again, should the Examiner believe otherwise, he is respectfully requested to point them out to Applicant as is mandated under MPEP §707.07(d).

In summary, Applicant believes that all pending claims 1 – 38 are now in condition to be passed to issuance. All rejections under 35 USC §112, second paragraph, should be withdrawn.

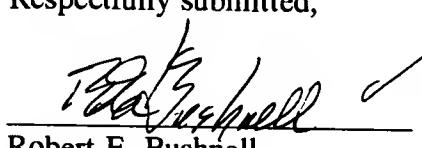
Although entry of Applicant's previous filed Amendment under 37 CFR §1.116(b) filed on 19 December 1994 is appreciated, in view of the outstanding §112 issues, Applicant respectfully requests the Examiner to enter the foregoing amendments in substitution of the previously filed Amendment so as to conclude prosecution of the instant application on the

merits. Entry of the foregoing amendments is believed to be proper under 37 C.F.R. §1.116(b) because those amendments simply respond to the issues raised in the final rejection, no new issues are raised, no further search is required, and the foregoing amendments are believed to remove the basis of the outstanding rejections and to place all claims in condition for allowance. The foregoing amendments, or explanations, could not have been made earlier because these issues had not previously been raised.

No fee is incurred by this response.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,

  
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